

Remarks

The Examiner has restricted the claims to one of the following inventions under 35 U.S.C. 121:

- I. Claims 1-26, drawn to a test set for characterizing substrate specificities of kinases with anchor amino acid(s).
- II. Claim 27, drawn to test set for characterizing substrate specificities of kinases with no anchor amino acid(s).
- III. Claims 28-30, drawn to a test set for characterizing substrate specificities of kinases wherein every residue is identical.
- IV. Claims 31-40, drawn to a binding entity whose binding differentiates between a defined peptide having the different, numerous recited sequences.
- V. Claims 41-55, drawn to a binding entity.
- VI. Claims 56-60, drawn to a method for characterizing substrate specificities of kinases.
- VII. Claims 61-68, drawn to a computer readable medium.

As indicated above, Applicant provisionally elects, without traverse, the claims of Group

V. Applicant notes that while there appears to be no species election requirement relating to Group V, Applicant provisionally elects, with traverse, as species SEQ ID NO:320.

Applicants respectfully traverse the requirement for electing single species of peptide epitope species. As provided by the MPEP, species may be related inventions and need not be subject to restriction. *See* MPEP § 806.04(b). In particular, where species are claimed under a

common genus and are related, the question of restriction is determined by the practice applicable to election of species and the practice applicable to other types of restrictions. *See id.* Applicants also respectfully remind the Examiner that they are entitled to examination of a reasonable number of species, and that election of species is for the convenience of the Examiner in initiating the search.

Here, at least claim 41 is generic with regard to the phosphorylated peptides. This generic claim explicitly defines how the claimed species are related – all phosphorylated peptides recognized by binding entities. Moreover, as detailed in the application, each peptide is susceptible to phosphorylation by the human kinase PKC-theta and each corresponds in structure to a human proteomic sequence following phosphorylation by PKC-theta.

The Examiner is reminded that M.P.E.P. § 803.02 states that “if the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the Examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the Examiner will not . . . require restriction. [S]hould no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended . . . to the extent necessary to determine patentability of the Markush-type claim.” (Emphasis added.)

Applicant requests reconsideration of the requirement for election of a species. If this request is denied, Applicant notes that during a telephone conversation on May 17, 2005, the Examiner agreed that, as required under M.P.E.P. § 803.02, additional species would be examined if a search of the elected species does not turn up relevant prior art.

Applicant also reserves the right to file a petition or a divisional application(s) on the non-elected claims.

Conclusion

Applicant respectfully requests a favorable examination of the merits of this patent application. The Examiner is invited to telephone Applicant's attorney at (516) 795-6820 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully Submitted,

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Date June 10, 2005 By Robin A. Chadwick
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CERTIFICATE UNDER 37 CFR § 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner for Patents, P.O.Box 1450, Alexandria, VA 22313-1450, on this 10th day of June 2005

Name PATRICIA A. HULTMAN Signature 